UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,669	06/01/2000	Thomas Moran	673-1005	4523

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EXAMINER
MILLS, DONALD L

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/585,669	MORAN, THOMAS
	Examiner	**Art Unit**	
	Donald L. Mills	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-62* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claim 35-41, 43-51, and 60-65 are rejected under 35 U.S.C. 102(e) as being anticipated

by Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

Regarding claims 35, 51, 60, and 62, Beyda discloses subconference calling, which

comprises:

Forming a main conference between a plurality of users (Managing subconference calls

within a main conference. See Abstract;)

Presenting at least one of said users in the main conference with a graphical list of the

main conference participants (Referring to Figures 1 and 2, the a list of users must inherently be

presented to an user in order for them to determine an appropriate subconference participant.

See column 5, lines 31-41;)

Providing said user with an interface to interact with said graphical list of main

conference participants, such that said user has an option to request a subconference with a

subset of other users by selecting subconference participants from said graphical list using said

interface (Referring to Figure 1, first terminal **14** transmits a subconference call request **28** to the

sixth terminal **24**, based upon the inherently known list of participants. See column 4, lines 33-40;)

Forming a subconference between the user and the subset of other users (The subconference call subsystem **30** establishes a first subconference call. See column 4, lines 52-54;)

Maintaining private from the main conference at least some communication between the subset of users in the subconference during the subsistence of the subconference (Referring to Figure 2, data router **36** transmits voice data generated from the first terminal **14** and sixth terminal **24** over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress (Referring to Figures 1 and 2, the list of the subset of users in the subconference is inherently present during the subconference between the first terminal **14** and the sixth terminal **24**. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 36, Beyda discloses *wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference* (Referring to Figure 2, data router **36** transmits voice data generated from the first terminal **14** and sixth terminal **24** over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 37, Beyda discloses *wherein the users in the subconference are prevented from contributing to the main conference but are able to monitor communications in the main conference during the subsistence of the subconference* (Voice data generated from first

terminal **14** and sixth terminal **24** are transmitted only to participants in the subconference call

and voice data from the main conference call is transmitted to all terminals. See column 4, lines

57-62.)

Regarding claims 38 and 61, Beyda discloses *wherein the main conference utilizes a*

plurality of media types, users in the subconference utilize one or more of said media types, and

users in the subconference can actively or passively participate in the main conference in at least

one media type during the subsistence of the subconference (Users in the subconference can

utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-

26.)

Regarding claim 39, Beyda discloses *wherein the users utilize a plurality of media types*

in the main conference and/or subconference, said media types being selected form the group

consisting of vide, audio and data signals (Users in the subconference can utilize video, audio,

and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 40, Beyda discloses *wherein the media types utilized in the main*

conference include video and audio, and wherein the subconference utilizes audio signals (Users

in the subconference can utilize video, audio, and whiteboard data from the main conference call.

See column 5, lines 22-26.)

Regarding claim 41, Beyda discloses *wherein the media types utilized in the main*

conference include audio and data, and wherein the subconference utilizes data signals (Users in

the subconference can utilize video, audio, and whiteboard data from the main conference call.

See column 5, lines 22-26.)

Regarding claim 43, Beyda disclose *wherein the users in the main conference are not presented with said subconference list during the subsistence of the subconference* (Referring to Figures 2, 3, and 6, the subconference subsystem prevents any second voice data **38** from the first subconference call from being transmitted over the main conference call. See column 6, lines 61-63. And, the subconference call subsystem **30** establishes the call in a manner that is transparent to the other terminals in the main conference call. See column 4, lines 54-57.))

Regarding claim 44, Beyda discloses *wherein the main conference is formed on a conference bridge to which each of the main conference users is connected* (The main conference is routed a data router **36**, or by a switch, hub, or bridge where the IP telephony terminals are connected. See column 4, lines 20-26.)

Regarding claim 45, Beyda discloses *wherein the subconference users remain connected to the bridge and the subconference is formed by creating a second conference on the bridge simultaneously with the main conference* (The subconference call subsystem **30** establishes the call in a manner that is transparent to the other terminals **16, 18, 20,** and **22** in the main conference call, which inherently resides on the same data router **36**. See column 4, lines 54-57.)

Regarding claim 46, Beyda discloses *wherein the user(s) to whom the request is addressed have the option of accepting or refusing to join the subconference, and wherein such acceptance or rejection determines whether or not they remain as part of said subset* (After transmitting the request to the sixth terminal **24**, the subconference call subsystem **30** monitors for an acceptance to the call set-up request which can be accepted or rejected, which inherently determines whether the sixth terminal **24** forms a subconference with the first terminal **14**. See column 4, lines 50-52.)

Regarding claim 47, Beyda discloses *wherein each user in the subconference is provided*

with the option to leave the subconference at any time during the subsistence of the

subconference (Referring to Figure 5, when a subconference call is established, at any time

during the subconference call, any terminal participating in the subconference call can transfer to

bi-directional transmission within the main conference call. See column 6, lines 27-30.)

Regarding claim 48, Beyda discloses *wherein users opting to leave the subconference are*

automatically returned to full participation in the main conference (Any terminal that can

transfer among each of its subconference calls and the main conference call. See column 6, lines

30-34.)

Regarding claim 49, Beyda discloses *wherein users in the subconference are presented*

with the option of requesting one or more of the other subconference users to join a nested

subconference within said initial subconference (Referring to Figures 3, 4, 5, and 7, the

subconference subsystem **30** monitor the main conference call and the first subconference call

for a second request to establish a second subconference call. See column 7, lines 6-10.)

Regarding claim 50, Beyda discloses *wherein users in the subconference are presented*

with the option of requesting one or more of the other subconference users to leave said initial

subconference and from a new subconference without rejoining the main conference (Referring

to Figure 5, the fourth terminal **20** can establish a second subconference call from either the first

subconference call or the main conference call. See column 6, lines 14-16.)

Regarding claim 63, Beyda discloses *means for enabling the user to select one or more*

media types for use during said subconference (Users in the subconference can utilize video,

audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 64, Beyda discloses *when embodied in a multimedia terminal for use in*

a conference (Referring to Figure 2, multimedia terminals **14** and **24**.)

Regarding claim 65, Beyda discloses *when embodied in the form of a telephone handset*

having a graphical display for presentation of said graphical list and input means for operation

of said interface (Referring to Figure 2, multimedia terminals **14** and **24**.)

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 42, 52-55, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda, in view of Hamilton (US

6,757,259 B1).

Regarding claims 42 and 58 as explained in the rejection statement of claims 35 and 51,

Beyda discloses all of the claim limitations of claims 35 and 51 (parent claim).

Beyda does not disclose *wherein the users in the main conference are presented with said*

subconference list during the subsistence of the subconference.

Beyda teaches that when a coordinator drops parties from the conference call to establish

a subconference call, the other coordinators in the call are able to detect that some parties have

been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the

time the invention was made to allow users in the main conference to see the list of

subconference users. One of ordinary skill in the art at the time the invention was made would

have been motivated to do so in order for users to establish subconferences with any user present

in the conferencing system.

Regarding claim 52 as explained in the rejection statement of claim 51, Beyda discloses

all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the main conference list memory unit and the*

subconference list memory unit are logical areas within a single memory unit.

Hamilton teaches a conference bridge comprising all memory within a central unit (See

Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to implement the memory units as a single memory unit of Hamilton in the

subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention

would have been motivated to do so in order to simplify system design, reduce system costs, and

improve efficiency.

Regarding claim 53 as explained in the rejection statement of claim 51, Beyda discloses

all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the functions of the main signal processing means and*

of the subconference signal processing means are carried out by the same signal processing unit.

Hamilton teaches a conference bridge comprising all signal processing within a central

unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to implement the signal processing as a single signal processing unit of Hamilton in

the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention

would have been motivated to do so in order to simplify system design, reduce system costs, and

improve efficiency.

Regarding claim 54, the primary reference further teaches *wherein said signal processing*

unit is adapted to combine signals of different media types (Users in the subconference can

utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-

26.)

Regarding claim 55, the primary reference further teaches *wherein said media types are*

selected form video, audio and data (Users in the subconference can utilize video, audio, and

whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 57, the primary reference further teaches *wherein said main control unit*

includes means for forwarding said list of users in the conference to each of the users (Referring

to Figure 1, first terminal **14** transmits a subconference call request **28** to the sixth terminal **24**,

based upon the inherently known list of participants. See column 4, lines 33-40.)

Regarding claim 59, the primary reference further teaches *a conferencing server*

connected to the conferencing server, and means for connecting users to the call server

(Managing subconference calls within a main conference. See Abstract.)

5.   Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US

6,404,873 B1), hereinafter referred to as Beyda in view of Hamilton, further in view of Theimer

et al. (US 5,812,865), hereinafter referred to as Theimer.

Regarding claim 56 as explained in the rejection statement of claim 51, Beyda discloses

all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose the *subconference control unit being dynamically programmable*

causing said subconference signal processing means to generate outgoing signal streams

containing a user selected combination of media types selected from the incoming signals for the

users subconference.

Theimer selectively establishing communications paths between media devices based on

the context of the users. For example, $user_A$ may set up an electronic conference with $user_B$.

$User_A$ may specify that a video connection is preferred, and $user_A$ may also accept telephone, or

voice only, connection (See column 27, lines 33-46.)

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to implement the selective communications path method of Theimer in the system of

Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a

system which allows users to select media data paths between users to tailor conferences to a

user's capabilities as taught by Theimer (See column 4, lines 10-13.)

Response to Arguments

6.   Applicant's arguments filed 08 April 2006 have been fully considered but they are not

persuasive.

Rejection Under 35 USC 102

On page 10 of the remarks, regarding claims 35, 51, 60, and 62, the Applicant argues

presenting a graphical list of main conference participants; providing the user with an interface

to allow selection of subconference participants from the graphical list; and presenting a

subconference list when the subconference is in progress are not inherent to Beyda. The

Examiner respectfully disagrees. Beyda teaches a first terminal **14** which transmits a

subconference call set-up request **28** to another conference call terminal to establish a

subconference call (See column 4, lines 36-40.) Beyda also explains that conventional

teleconferencing technology is not conducive to conducting private subconferences (See column

1, lines 23-32.) A participant in the main conference must inherently be presented with a list of

fellow participants, otherwise, it would be impossible to establish a discrete subconference call

within the context of the main conference since the identities of the other participants would be

unknown. Further, if the identities of the main conference participants were not displayed to the

users, one wishing to establish a subconference call would be unaware of whom to send a

subconference call set-up request. On page 11 of the remarks, the Applicant argues, "the

terminals do not need to know of one another's existence to transmit a request." The Examiner

respectfully disagrees. Beyda further explains that conferees can establish a subconference call

to discuss an issue exclusively with a particular conferee (See column 7, lines 50-54.) Therefore,

the conferees existence must be known since the originator of the subconference directs the

request to a distinct and specific user. In addition, Beyda presents a subconference list to the

subconference participants when the subconference is in session as the video and digital data

presented to the users (See column 5, lines 19-26.) Therefore, Beyda teaches *presenting a*

graphical list of main conference participants; providing the user with an interface to allow

selection of subconference participants from the graphical list; and presenting a subconference

list when the subconference is in progress.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Donald L. Mills whose telephone number is 571-272-3094. The

examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Donald L Mills

July 3, 2006

SEEMA S. RAO   7/10/06
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